

REMARKS

Applicant respectfully requests reconsideration. Claims 1, 2, 4-11, 13, 15, 17-19, 22, 28, 30, 31, 34-37, 39-47, 49-65, 67-82 and 93-97 were previously pending in this application. Claims 39-47, 49-65 and 67-80 have been cancelled. No new matter has been added.

Rejections Under 35 U.S.C. §112, First Paragraph

Claims 22 and 95 have been rejected under 35 U.S.C. §112, first paragraph as failing to comply with the written description requirement. Specifically, the Office Action states that the specification fails to teach combining a fourth fluid and a second fluid while transferring the first, third, and second fluids from the vessel to the reaction site as recited in claim 22, or a sixth fluid formed from mixing a fourth and fifth fluid as recited in claim 95. The Office Action also notes that “fifth” and “sixth” fluids are not mentioned in the specification, and that original claim 22 recited mixing a fourth fluid with a third fluid for forming a second fluid (and not combining a fourth fluid and a second fluid as currently claimed).

Regarding claim 22, Applicant believes that one of ordinary skill in the art would understand, after reading the claims in light of the specification, that fluids labeled “first”, “second”, “third” fluids and such is arbitrary and that any suitable combination of fluids can be used and/or combined. In original claim 22, a fourth fluid was combined with a third fluid because the term “third fluid” had not yet been introduced into claim 1. Upon amendment of claim 1 (in a preliminary amendment filed August 21, 2009) to introduce a “third fluid” as a fluid separating the first and second fluids, Applicant wished to amend claim 22 accordingly. Thus, the subject matter recited in pending claim 22 is supported by at least original claim 22 and the specification as filed.

Claim 95 recites a first branch containing a fourth fluid and a second branch containing a fifth fluid, the fourth and fifth fluids adapted and arranged to react with one another to form a sixth fluid. This claim is supported by at least original claim 22 and page 16, lines 20-27, which teaches fluids being contained in branches and the mixing of fluids in such branches. Again, even though the labeling of the fluids may differ between this support and the claim as pending, it is clear that the inventors had possession of this concept at the time of filing of the application.

Moreover, the specification states that “Any number of distinct fluids may be contained in a vessel” (see page 13, line 13), and FIGS. 12-17 clearly show that more than four fluid plugs can be stored in a vessel. Although these fluids are not explicitly labeled as “fourth”, “fifth” or “sixth” fluids, it is clear that the inventors had possession of including a plurality of fluid plugs in a vessel at the time of filing of the application.

Claim 97 has been rejected under 35 U.S.C. §112, first paragraph as failing to comply with the written description requirement. Specifically, the Office Action states that there is no support in the specification for introducing a sample from a vessel different from the vessel containing the first, third, and second fluids.

Applicant believes that the subject matter of claim 97 is supported in the specification as filed. For example, the specification states that a device may include “a reactive site [which] may be integrally or non-integrally connected to a sampling device, such as a sampling tube. The sampling tube may have one end associated with a channel or chamber housing the reaction site. An opposing end of the tube may be dipped into a sample source (that may be a container or may be a subject) to be analyzed or reacted.” (See page 23, lines 1-5.) The specification further teaches that an end of the sampling tube may be in fluid communication with the downstream side of the vessel containing fluids. (See page 23, lines 10-12.) Thus, the inventors clearly had possession of the concept of a sample being placed in a vessel different from that of the first, third and second fluids at the time of filing.

Accordingly, withdrawal of the claim rejections on these grounds is respectfully requested.

Rejections Under 35 U.S.C. §102

Claims 1, 2, 4, 6-11, 13, 16-19, 34-37, 81-82, 93, 96, 97 are rejected under 35 U.S.C. §102(e) as being anticipated by Sia et al., U.S. Publication No. 2007/0298433 (hereinafter, “Sia”).

Applicant submits that Sia is not a proper reference under 35 U.S.C. §102(e) for the subject matter recited in the claims rejected on this ground. Since the subject matter of the present application was first incorporated by reference into Sia via U.S. Provisional Application Serial No. 60/539,416, filed January 26, 2004, to which the present application also claims priority, it is

believed that Sia is not a reference that renders the above claims unpatentable under 35 U.S.C. §102(e).

On this basis, it is believed that the rejection of the claims over Sia cannot be maintained, and it is respectfully requested that the rejection be withdrawn.

Rejections Under 35 U.S.C. §103

Claims 28, 30-31 are rejected under 35 U.S.C. §103(a) as being unpatentable over Sia.

Applicant believes that Sia is not a proper reference under 35 U.S.C. §102 for the subject matter recited in the claims rejected on this ground for the same reasons noted above; therefore, Sia is not a proper reference under 35 U.S.C. §103(a) (see, e.g., MPEP §2141.01, I).

Claims 5 and 94 are rejected under 35 U.S.C. §103(a) as being unpatentable over Sia in view of Jeon et al., U.S. Patent No. 6,705,357 (hereinafter, "Jeon").

Applicant submits that the combination of Sia in view of Jeon is improper, because Sia is not a proper reference under 35 U.S.C. 103(a) for the subject matter of the claims rejected on this ground.

For at least these reasons, it is believed that the rejection has been overcome and it is respectfully requested that the rejection be withdrawn.

Double Patenting Rejection

Claims 1, 2, 7, 8, 11, 13, 35-37, and 81-94 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 45-46, 48, 51-53, 72-102 of copending Application No. 10/584,819 (Sia).

Applicant acknowledges the rejection of claims 1, 2, 7, 8, 11, 13, 35-37, and 81-94 on these grounds, but respectfully defers addressing this issue until later in prosecution, if necessary, depending on the prosecution of this application and any claims allowed in U.S. Patent Application Serial No. 10/584,819.


CONCLUSION

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 23/2825 under Docket No. H0498.70219US02 from which the undersigned is authorized to draw.

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Respectfully submitted,

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